

## REMARKS

Claims 1-22 are currently pending in this application. The Office has rejected claims 1-7, 9, 13, 16-18, 20 and 22 under 35 U.S.C. § 102(e) as being anticipated by Swartz et al. (U.S. Pub. No. 2003/0132298; hereafter “Swartz”). Claims 8, 14 and 19 are rejected under 35 USC § 103(a) as being unpatentable by Swartz in view of Sloane (U.S. Pat. No. 5,918,211). The Office rejected claim 15 under 35 USC § 103(a) as being unpatentable over Swartz in view of Sloane and further in view of Panofsky et al. (U.S. Pub. No. 2002/0161476; hereafter “Panofsky”). This is a non-final Office action and is responsive to Applicant’s communication filed on or about August 20, 2009.

### 102(e) Rejection of Independent Claims 1, 3, 4, 20 and 22 by Swartz

#### *Re: Claim 1:*

The Office has failed to establish a *prima facie case* of anticipation because it has failed to show the reference is anticipatory as required by section 102(e). For a reference to be anticipatory, “the reference must disclose each and every element of the claimed invention ... arranged or combined in the same way as in the claim.” (*In Re Martin Gleave and Maxim Signaevsky*, 560 F.3d 1334; 2009 U.S. Court of App. Fed. Cir.) The Office has failed to meet this requirement.

In supporting the rejection of claim 1, the Office states multiple times that the reference “could” have a required element but fails to establish that the reference actually does show or suggest the element. For example, the Office states, “although these controllers are shown as physically separated items, they could also be logical distinct software items in a single hardware device.” (Office Action, page 3, second full paragraph.) The reference clearly teaches, “physically separated items” but the Office asserts, “they could also” be in a “single hardware device.” However, the Office fails to provide any teaching from the reference that would support this assertion.

The Office also cites paragraph 211 and states, “The system could also use the information in determining whether to send a promotional message to a customer.” (*Id.*) The Office provides no teaching from the reference to support this position. To the

contrary, the reference actually teaches away from the required element. Applicant requires “a customer interface device ... alerting a customer to the existence of a promotion for an item scanned at the checkout counter.” Ignoring for the moment that the reference fails to teach the item is scanned at the checkout counter, the reference teaches, “if a customer has on his electronic list a particular item, the system may not offer a discount to the customer to purchase this item. Since the customer’s shopping list indicates that the customer already has a predisposition to purchase the product.” (Swartz, paragraph 211.) This cited passage teaches away from Applicant’s requirement to alert the customer to a promotion for an item scanned.

Finally, the Office states, “[para. 0108] via The code could be in the form of a one dimensional barcode for looking up the relevant information in a database.” (*Id.*) Again the Office asserts what “could be” but fails to state what claimed element is being referenced or where the element is disclosed in the reference. Further, Applicant is not sure what element from the claimed invention the Office is addressing. The reference in the cited passage does disclose, “the receipt preferably has a code for determining all of the products (and their cost) purchased by the customer.” This is not what Application requires. Applicant requires, “the details of the promotion appear as bar code data to the point-of-sale computer.” It is unclear how the reference teaches this requirement.

As shown above, the Office has failed to establish that Swartz anticipates all the elements required in Applicant’s claimed invention. The rejection is therefore improper and Applicant request that it be withdrawn and all claims so rejected allowed.

Further, failure to specifically identify which features of Swartz are believed to disclose each element of the claims likely renders the Office Action “arbitrary and capricious”, and therefore invalid, under the Administrative Procedure Act (5 U.S.C. § 706), a standard to which all Actions by the USPTO must adhere (see *Dickenson v. Zurko*, 527 U.S. 150 (1999)). Without proper guidance as to which “element” of the claim is believed to correspond with which section cited in the rejection, Applicant is forced to guess which features in the cited art the Examiner believed to disclose each of the claimed features.

Because Applicant’s claimed elements were not identified in the Office Action and Applicant cannot reasonably determine which features of Swartz is believed to

correspond with which features recited in the claims, it is respectfully submitted that the rejection is improper and must be withdrawn.

*Re: Claim 3, 4, 20 and 22:*

The rejections for these claims are improper for one or more of the same reasons given above for claim 1 and should therefore be allowed for the same reasons.

103(a) Rejection of Dependent Claims 8, 14 and 19 by Swartz and Sloane

Sloane teaches a system and method for influencing and potentially altering a consumer's purchase decisions at the point-of-purchase in a retail store using a portable bar code scanner. (See Sloane abstract.) Sloane's teachings also fail to show or suggest the above elements that the Office has failed to show were disclosed by Swartz.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required elements of Applicant's claimed invention. The rejection is therefore improper and Applicant requests that it be withdrawn.

103(a) Rejection of Dependent Claim 15 by Swartz, Sloane and Panofsky

Panofsky teaches "a system and method for the contemporaneous use of a vending machine and host terminal to interact with digital files." (Panofsky, Abstract.) Panofsky's teachings also fail to show or suggest the above elements missing from the other references cited by the Office.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required elements of Applicant's claimed invention. The rejection is therefore improper and Applicant requests that it be withdrawn.

## CONCLUSION

Applicant asks the Office to reconsider this application and allow all pending claims. Please charge any fees that might be due, excluding the issue fee, to deposit account 14-0225.

Respectfully submitted,

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/Harden E. Stevens, III/  
Harden E. Stevens, III  
Reg. No. 55,649

NCR Corporation  
1700 South Patterson Blvd.  
Dayton, Ohio 45479

(803) 939-6505  
(803) 939-5521 (fax)  
Email: [steve.stevens@ncr.com](mailto:steve.stevens@ncr.com)